

PATENT**Application # 10/730,577**

Attorney Docket # 2000-0222 (1014-056)

REMARKS**RECEIVED
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The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 3 and 17 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-27 are now pending in this application. Each of claims 1, 10, and 27 are in independent form.

I. The Obviousness-Type Double Patenting Rejections

Each of claims 1-27 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,751,441 ("Murray"). These rejections are respectfully traversed.

Submitted herewith is a Terminal Disclaimer to Obviate a Double Patenting Rejection.

It is believed that with this Terminal Disclaimer, all claims in this application are in condition for allowance, prompt notice of which is respectfully solicited.

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II. The Rejections

A. Anticipation

1. Set I

Each of claims 1, 2, 4, 6, 7, 10-12, 14-24, 26, and 27 was rejected as anticipated under 35 U.S.C. 102(e). In support of the rejection, various portions of U.S. Patent No. 6,681,116 ("Johnson") and/or U.S. Patent No. 6,377,782 ("Bishop") were applied. These rejections are respectfully traversed.

2. Set II

Claim 1 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent No. 5,930,247 ("Miller") were applied. These rejections are respectfully traversed.

3. Set III

Claim 1 was rejected as anticipated under 35 U.S.C. 102(b). In support of the rejection, various portions of U.S. Patent No. 5,708,961 ("Hylton") were applied. These rejections are respectfully traversed.

B. Obviousness

Each of claims 3, 5, 8, 9, 13, and 25 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 6,681,116 ("Johnson") in view of U.S. Patent No. 6,377,782 ("Bishop"). Each of these rejections is respectfully traversed.

C. The Legal Standards

1. Express Anticipation

To establish a *prima facie* case of express anticipation, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001); *See also*,

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MPEP 2131. The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), cert. denied, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

The USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967).

2. *Prima Facie* Criteria for an Obviousness Rejection

Over 50 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357.

Instead, "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in

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the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach... all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

3. Claim Construction

Before the *prima facie* obviousness criteria can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), cert. denied, 2006 U.S. LEXIS 1154, 2006 WL 386393, 126 S. Ct. 1174, 164 L.Ed.2d 49 (2006) has clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art'" (*Id.* at 1316);
2. the words of a claim "are generally given their ordinary and customary meaning" (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is "the meaning that the term

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would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application" (*Id.* at 1313);

4. "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent, including the specification**" (*Id.*);
5. even "the context in which a term is used in the asserted claim can be highly instructive" (*Id.* at 1314);
6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the **inventor's lexicography governs**" (*Id.* at 1316);
7. even "when guidance is not provided in explicit definitional format, the specification **may define claim terms by implication** such that the **meaning** may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321);
8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited** during the examination of the patent" (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

4. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered....'" MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); see also, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

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5. Official Notice

Regarding Official Notice, MPEP § 2144.03.A states (emphasis added):

[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of... specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. See also *In re Grose*, 592 F.2d 1161, 1167-68, 201 USPQ 57, 63 (CCPA 1979).

Further, if an applicant traverses the examiner's assertion of official notice, the examiner **must provide documentary evidence in the next Office Action if the rejection is to be maintained.** See 37 CFR 1.104(c)(2) and MPEP 2144.03C. See also *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) ("[T]he Board cannot simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. See *In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.*

6. Unfounded Assertions of Knowledge

A bald assertion of knowledge generally available to one of ordinary skill in the art to bridge the evidentiary gap is improper. Such unfounded assertions are not permissible substitutes for evidence. See, *In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). That is, deficiencies of the cited references can not be remedied by general conclusions

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about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).

7. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is "reasonably pertinent to the particular problem with which the invention was involved." *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

"References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) ("[I]t is necessary to consider 'the reality of the circumstances,'—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor" (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

"If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*citing In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*quoting Ecolochem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

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8. Motivation or Suggestion to Combine Prior Art References

Under the *Graham* analysis, the "examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." See, MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must clearly and objectively prove "the reasons one of ordinary skill in the art would have been motivated to select the references". *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998); *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006).

Further, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed" (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

To show these reasons, "[p]articular findings must be made". *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by "concrete evidence in the record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be "clear and particular". *In re Dembicczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 161(Fed. Cir. 1999). That strong showing is needed because, "obviousness requires proof 'that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed'". *In re Johnston*, 435 F.3d 1381 (Fed. Cir. 2006) (quotation omitted) (emphasis added).

Thus, the Office Action must clearly, particularly, and objectively prove some "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

- "select the references";
- "select the teachings of [the] separate references"; and
- "combine [those teachings] in the way that would produce the claimed" subject matter.

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In re Johnston, 435 F.3d 1381 (Fed. Cir. 2006) (internal citations omitted). See also, *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing “the test of whether it would have been obvious to select specific teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (“When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”). “The absence of . . . a suggestion to combine is dispositive in an obviousness determination.” *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997).

Further, these requirements apply regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

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9. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

D. Analysis

1. Claim 1

a. Set I

With respect to the rejection of claim 1, the Office Action improperly references a large portion of, and/or the entire specification of Johnson, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” *See also*, MPEP 707.07(d), “where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated” and MPEP 706.02(i), “**the particular part of the reference relied upon to support the rejection should be identified.**” Designation of the particular part of Johnson relied upon to support the rejection of claim 1 is respectfully requested.

With respect to the rejection of claim 1, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “[t]he pertinence of each reference... must be clearly explained and each rejected claim specified.” *See also*, MPEP 707.05, when “prior art is cited, its pertinence

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should be explained." A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 1 is respectfully requested.

Johnson fails to establish a *prima facie* case of anticipation.

Specifically, claim 1, from which each of claims 2-9 depends, recites, *inter alia*, yet Johnson does not teach "an adjunct device connected to the broadband interface device and operative for accepting broadband signals, **formatting the broadband signals for wireless delivery and providing the formatted broadband signals to the in-premises cabling**".

Instead, Johnson allegedly recites, at col. 4, lines 45-67 (emphasis added):

PCS device 202 could be any device configured to exchange either the second or third inter-node signals with inter-node link 218 and exchange PCS wireless signals 212 over a wireless communication path. One example of PCS device 202 is a mobility PCS wireless device.

CDMA device 208 could be any device configured to exchange either the second or third inter-node signals with inter-node link 218 and exchange CDMA signals 210 over a wireless communication path. One example of CDMA device 208 is high data rate CDMA wireless device.

Millimeter wave device 204 could be any device configured to exchange either the second or third inter-node signals with inter-node link 218 and exchange millimeter wave signals 214 over a wireless communication path. One example of millimeter device 204 is a broadband millimeter wave wireless device.

Microwave device 206 could be any device configured to exchange either the second or third inter-node signals with inter-node link 218 and exchange microwave signals 216 over a wireless communication path. One example of microwave device 206 is a microwave multipoint distribution device.

Applicant respectfully submits that Johnson does not teach, "an adjunct device connected to the broadband interface device and operative for accepting broadband signals, **formatting the broadband signals for wireless delivery and providing the formatted broadband signals to the in-premises cabling**".

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For at least these reasons, it is respectfully submitted that the rejection of claim 1 is unsupported by Johnson and should be withdrawn. Also, the rejection of claims 2-9, each ultimately depending from independent claim 1, is unsupported by Johnson and also should be withdrawn.

b. Set II

With respect to the rejection of claim 1, the Office Action improperly references a large portion of, and/or the entire specification of Miller, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states "when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." *See also*, MPEP 707.07(d), "where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated" and MPEP 706.02(i), "**the particular part of the reference relied upon to support the rejection should be identified.**" Designation of the particular part of Miller relied upon to support the rejection of claim 1 is respectfully requested.

With respect to the rejection of claim 1, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states "[t]he pertinence of each reference... must be clearly explained and each rejected claim specified." *See also*, MPEP 707.05, when "prior art is cited, its pertinence should be explained." A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 1 is respectfully requested.

Miller fails to establish a *prima facie* case of anticipation.

Specifically, claim 1, from which each of claims 2-9 depends, recites, *inter alia*, yet Miller does not teach "an adjunct device connected to the broadband interface device and operative for accepting broadband signals, **formatting the broadband signals for wireless delivery and providing the formatted broadband signals to the in-premises cabling**".

Instead, Miller recites, at col. 2, line 60 – col. 3, line 7 (emphasis added):

[t]he data port 111 is also connected, through the router 125 to the radio modem 141 which is a PC-MCIA card containing a CDPD radio modem for

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communicating, via a 1/4 wave vertical antenna 142 with a CDPD (Cellular Digital Packet Data) wireless packet network. CDPD is a commercially available service and is well known to those skilled in the art. Its primary value is as a back-channel for internet surfing where the downlink is via DirecTV™ service. This unit also provides the capability for the LAN to communicate outside the LAN with other data systems through the router 125 and CDPD modem 141 to a CDPD wireless network. It receives its data packets for transmission directly from the router 125, via lead 147, and transmits them by radio transmission (i.e., cellular transmission) to a cellular CDPD wireless system via it output antenna 142.

Applicant respectfully submits that Miller does not teach, “an adjunct device connected to the broadband interface device and operative for accepting broadband signals, formatting the broadband signals for wireless delivery and providing the formatted broadband signals to the in-premises cabling”.

For at least these reasons, it is respectfully submitted that the rejection of claim 1 is unsupported by Miller and should be withdrawn.

c. Set III

With respect to the rejection of claim 1, the Office Action improperly references a large portion of, and/or the entire specification of Hylton, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” *See also*, MPEP 707.07(d), “where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated” and MPEP 706.02(i), “the particular part of the reference relied upon to support the rejection should be identified.” Designation of the particular part of Hylton relied upon to support the rejection of claim 1 is respectfully requested.

With respect to the rejection of claim 1, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R

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1.104(c)(2), which states “[t]he pertinence of each reference... must be clearly explained and each rejected claim specified.” *See also*, MPEP 707.05, when “prior art is cited, its pertinence should be explained.” A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 1 is respectfully requested.

Hylton fails to establish a *prima facie* case of anticipation.

Specifically, claim 1, from which each of claims 2-9 depends, recites, *inter alia*, yet Hylton does not teach “an adjunct device connected to the broadband interface device and operative for accepting broadband signals, formatting the broadband signals for wireless delivery and providing the formatted broadband signals to the in-premises cabling”.

Instead, Hylton allegedly recites, at col. 10, lines 1-8 (emphasis added):

[a]s shown by the above overview, the use of wireless distribution on the premises eliminates the need to install cabling or wiring from the point that the network 5 enters the premises to the individual terminals 100. Also, if the user so desires, the user can move the set-top 100 and associated television set 103 to a new location within range of the shared processing system 10, without any need to modify the wiring or install any new cables.

Applicant respectfully submits that Hylton does not teach, “an adjunct device connected to the broadband interface device and operative for accepting broadband signals, formatting the broadband signals for wireless delivery and providing the formatted broadband signals to the in-premises cabling”.

For at least these reasons, it is respectfully submitted that the rejection of claim 1 is unsupported by Hylton and should be withdrawn.

2. Claim 2

Since claim 2 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 2 is unsupported by Johnson and should be withdrawn.

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3. Claim 3

Since claim 3 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents no proof, and indeed no evidence, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."

Instead, regarding selected proffered combinations, the present Office Action asserts:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Bishop into the system of Johnson in order to enhance the system performance of the communication system.

Applicant respectfully submits that this unsupported assertion provides no evidence of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or

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3. "combine [those teachings] in the way that would produce the claimed" subject matter.

c. Conclusion

Thus, the Office Action fails to present the required proof of obviousness. For at least these reasons, it is respectfully submitted that the rejection of claim 3 is unsupported by Johnson and should be withdrawn.

4. Claim 4

Since claim 4 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 4 is unsupported by Johnson and should be withdrawn.

5. Claim 5

Since claim 5 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Official Notice

The present Office Action takes Official Notice regarding the claimed subject matter of claim 5, which is admittedly not present in any applied portion of any relied upon reference. Applicant respectfully traverses this Official Notice and respectfully requests a citation and provision of a reference that supports the rejection.

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c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents no proof, and indeed no evidence, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."

Instead, regarding selected proffered combinations, the present Office Action asserts:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the reciting limitations into the system of Johnson and Bishop in order to enhance the system performance of the communication system.

Applicant respectfully submits that this unsupported assertion provides no evidence of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

d. Conclusion

Thus, the Office Action fails to present the required proof of obviousness. For at least these reasons, it is respectfully submitted that the rejection of claim 5 is unsupported by Johnson and should be withdrawn.

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6. Claim 6

Since claim 6 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 6 is unsupported by Johnson and should be withdrawn.

7. Claim 7

Since claim 7 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 7 is unsupported by Johnson and should be withdrawn.

8. Claim 8

Since claim 8 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Official Notice

The present Office Action takes Official Notice regarding the claimed subject matter of claim 8, which is admittedly not present in any applied portion of any relied upon reference. Applicant respectfully traverses this Official Notice and respectfully requests a citation and provision of a reference that supports the rejection.

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c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever, of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:**

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything “in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.”**

Instead, regarding selected proffered combinations, the present Office Action asserts:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the reciting limitations into the system of Johnson and Bishop in order to enhance the system performance of the communication system.

Applicant respectfully submits that this unsupported assertion provides no evidence of any “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed” subject matter.

d. Conclusion

Thus, the Office Action fails to present the required **proof of obviousness**. For at least these reasons, it is respectfully submitted that the rejection of claim 8 is unsupported by Johnson and should be withdrawn.

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9. Claim 9

Since claim 5 depends from claim 1, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 1 by reference herein.

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof**, and notably **no evidence** whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof**, and indeed **no evidence**, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." The present Office Action is completely silent regarding any suggestion, motivation, and/or desirability of combining the applied portions of the relied upon references to arrive at the claimed subject matter.

c. Conclusion

Thus, the Office Action fails to present the required **proof** of obviousness. For at least these reasons, it is respectfully submitted that the rejection of claim 9 is unsupported by Johnson and should be withdrawn.

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10. Claim 10

With respect to the rejection of claim 10, the Office Action improperly references a large portion of, and/or the entire specification of Bishop, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” *See also*, MPEP 707.07(d), “where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated” and MPEP 706.02(i), “**the particular part of the reference relied upon to support the rejection should be identified.**” Designation of the particular part of Bishop relied upon to support the rejection of claim 10 is respectfully requested.

With respect to the rejection of claim 10, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “[t]he pertinence of each reference... must be clearly explained and each rejected claim specified.” *See also*, MPEP 707.05, when “prior art is cited, its pertinence should be explained.” A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 10 is respectfully requested.

Bishop fails to establish a *prima facie* case of anticipation.

Specifically, claim 10, from which each of claims 11-16 depends, recites, *inter alia*, yet Bishop does not teach ‘providing the packetized and modulated RF frequency signals to in-premises cabling for distribution to signal radiation devices located within the premises’.

Instead, Bishop allegedly recites, at the Abstract (emphasis added):

[a] method of upstream communication over a linear broadband network includes the steps of generating an upstream baseband signal and modulating it onto an upstream wireless radio frequency carrier to produce a first upstream modulated carrier signal. The modulated carrier signal is transmitted wirelessly, received, and demodulated to reproduce the information integrity of the upstream baseband signal.

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Applicant respectfully submits that Bishop does not teach, "providing the packetized and modulated RF frequency signals to in-premises cabling for distribution to signal radiation devices located within the premises".

For at least these reasons, it is respectfully submitted that the rejection of claim 10 is unsupported by Bishop and should be withdrawn. Also, the rejection of claims 11-16, each ultimately depending from independent claim 10, is unsupported by Bishop and also should be withdrawn.

11. Claim 11

Since claim 11 depends from claim 10, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 10 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 11 is unsupported by Bishop and should be withdrawn.

12. Claim 12

Since claim 12 depends from claim 10, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 10 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 12 is unsupported by Bishop and should be withdrawn.

13. Claim 13

Since claim 13 depends from claim 10, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 10 by reference herein.

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

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b. Official Notice

The present Office Action takes Official Notice regarding the claimed subject matter of claim 13, which is admittedly not present in any applied portion of any relied upon reference. Applicant respectfully traverses this Official Notice and respectfully requests a citation and provision of a reference that supports the rejection.

c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents **no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to"**:

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents **no proof, and indeed no evidence, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."**

Instead, regarding selected proffered combinations, the present Office Action asserts:

it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the reciting limitations into the system of Johnson and Bishop in order to enhance the system performance of the communication system.

Applicant respectfully submits that this unsupported assertion provides no evidence of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

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d. Conclusion

Thus, the Office Action fails to present the required proof of obviousness. For at least these reasons, it is respectfully submitted that the rejection of claim 13 is unsupported by Bishop and should be withdrawn.

14. Claim 14

Since claim 14 depends from claim 10, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 10 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 14 is unsupported by Bishop and should be withdrawn.

15. Claim 15

Since claim 15 depends from claim 10, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 10 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 15 is unsupported by Bishop and should be withdrawn.

16. Claim 16

Since claim 16 depends from claim 10, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 10 by reference herein.

Claim 16 states, *inter alia*, yet the applied portions of Bishop do not teach, "supplying the broadband signals by DSL". The applied portions of Bishop do not even mention "DSL".

For at least these reasons, it is respectfully submitted that the rejection of claim 16 is unsupported by Bishop and should be withdrawn.

17. Claim 17

With respect to the rejection of claim 17, the Office Action improperly references a large portion of, and/or the entire specification of Bishop, thereby failing to meet the requirements of

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37 C.F.R 1.104(c)(2), which states "when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." *See also*, MPEP 707.07(d), "where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated" and MPEP 706.02(i), "**the particular part of the reference relied upon to support the rejection should be identified.**" Designation of the particular part of Bishop relied upon to support the rejection of claim 17 is respectfully requested.

With respect to the rejection of claim 17, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states "[t]he pertinence of each reference... must be clearly explained and each rejected claim specified." *See also*, MPEP 707.05, when "prior art is cited, its pertinence should be explained." A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 17 is respectfully requested.

Bishop fails to establish a *prima facie* case of anticipation.

Specifically, claim 17, from which each of claims 18-27 depends, recites, *inter alia*, yet Bishop does not teach "transmitting the modulated converted broadband information at the RF second frequency and via on-premise cabling".

Instead, Bishop allegedly recites, at the Abstract (emphasis added):

[a] method of upstream communication over a linear broadband network includes the steps of generating an upstream baseband signal and modulating it onto an upstream wireless radio frequency carrier to produce a first upstream modulated carrier signal. The modulated carrier signal is transmitted wirelessly, received, and demodulated to reproduce the information integrity of the upstream baseband signal.

Applicant respectfully submits that Bishop does not teach, "transmitting the modulated converted broadband information at the RF second frequency and via on-premise cabling".

For at least these reasons, it is respectfully submitted that the rejection of claim 17 is unsupported by Bishop and should be withdrawn. Also, the rejection of claims 18-27, each

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ultimately depending from independent claim 17, is unsupported by Bishop and also should be withdrawn.

18. Claim 18

Since claim 18 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 18 is unsupported by Bishop and should be withdrawn.

19. Claim 19

Since claim 19 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 19 is unsupported by Bishop and should be withdrawn.

20. Claim 20

Since claim 20 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

With respect to the rejection of claim 20, the Office Action improperly references a large portion of, and/or the entire specification of Bishop, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states "when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." *See also*, MPEP 707.07(d), "where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated" and MPEP 706.02(i), "the particular part of the reference relied upon to support the rejection should be identified." Designation of the particular part of Bishop relied upon to support the rejection of claim 20 is respectfully requested.

With respect to the rejection of claim 20, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R

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1.104(c)(2), which states “[t]he pertinence of each reference... must be clearly explained and each rejected claim specified.” *See also*, MPEP 707.05, when “prior art is cited, its pertinence should be explained.” A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 20 is respectfully requested.

For at least these reasons, it is respectfully submitted that the rejection of claim 20 is unsupported by Bishop and should be withdrawn.

21. Claim 21

Since claim 21 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 21 is unsupported by Bishop and should be withdrawn.

22. Claim 22

Since claim 22 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

With respect to the rejection of claim 22, the Office Action improperly references a large portion of, and/or the entire specification of Bishop, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” *See also*, MPEP 707.07(d), “where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated” and MPEP 706.02(i), “the particular part of the reference relied upon to support the rejection should be identified.” Designation of the particular part of Bishop relied upon to support the rejection of claim 22 is respectfully requested.

With respect to the rejection of claim 22, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states “[t]he pertinence of each reference... must be clearly explained and each rejected claim specified.” *See also*, MPEP 707.05, when “prior art is cited, its pertinence

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should be explained." A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 22 is respectfully requested.

For at least these reasons, it is respectfully submitted that the rejection of claim 22 is unsupported by Bishop and should be withdrawn.

23. Claim 23

Since claim 23 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

With respect to the rejection of claim 23, the Office Action improperly references a large portion of, and/or the entire specification of Bishop, thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states "when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable." *See also*, MPEP 707.07(d), "where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated" and MPEP 706.02(i), "**the particular part of the reference relied upon to support the rejection should be identified.**" Designation of the particular part of Bishop relied upon to support the rejection of claim 23 is respectfully requested.

With respect to the rejection of claim 23, the Office Action fails to explain the pertinence of the applied portions of the reference(s), thereby failing to meet the requirements of 37 C.F.R 1.104(c)(2), which states "[t]he pertinence of each reference... must be clearly explained and each rejected claim specified." *See also*, MPEP 707.05, when "prior art is cited, its pertinence should be explained." A clear explanation of the pertinence of the applied portions of each reference that is relied upon to support the rejection of claim 23 is respectfully requested.

For at least these reasons, it is respectfully submitted that the rejection of claim 23 is unsupported by Bishop and should be withdrawn.

24. Claim 24

Since claim 24 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

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For at least these reasons, it is respectfully submitted that the rejection of claim 24 is unsupported by Bishop and should be withdrawn.

25. Claim 25

Since claim 25 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

a. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

b. Official Notice

The present Office Action takes Official Notice regarding the claimed subject matter of claim 25, which is admittedly not present in any applied portion of any relied upon reference. Applicant respectfully traverses this Official Notice and respectfully requests a citation and provision of a reference that supports the rejection.

c. No Motivation or Suggestion to Combine the Applied References

The present Office Action presents no proof, and notably no evidence whatsoever, of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

Moreover, the present Office Action presents no proof, and indeed no evidence, of anything "in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination."

Instead, regarding selected proffered combinations, the present Office Action asserts:

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it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the reciting limitations into the system of Johnson and Bishop in order to enhance the system performance of the communication system.

Applicant respectfully submits that this unsupported assertion provides no evidence of any "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed" subject matter.

d. Conclusion

Thus, the Office Action fails to present the required proof of obviousness. For at least these reasons, it is respectfully submitted that the rejection of claim 25 is unsupported by Bishop and should be withdrawn.

26. Claim 26

Since claim 26 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 26 is unsupported by Bishop and should be withdrawn.

27. Claim 27

Since claim 27 depends from claim 17, Applicant respectfully incorporates by reference each argument regarding the rejection of claim 17 by reference herein.

For at least these reasons, it is respectfully submitted that the rejection of claim 27 is unsupported by Bishop and should be withdrawn.

To: 571-273-8300

From: Eden at MichaelHaynes.com

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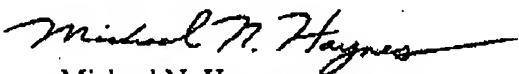
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the **OCT 24 2006** application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes
Registration No. 40,014

Date: 24 October 2006

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